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09/781,679

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Charles E. Hunter

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EXAMINER

RAMAN, USHA

ART UNIT

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2623

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/781,679

Applicant(s)

HUNTER ET AL.

Examiner

Usha Raman

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41,42,44-52,57-68,70-78 and 100-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41,42,44-52,57-68,70-78 and 100-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-4-07</u> . | 6) <input type="checkbox"/> Other: _____  |

***Information Disclosure Statement***

1. The information disclosure statement filed October 4<sup>th</sup>, 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. A copy of "DVD-Video Format Book Specification" (listed as # 136 on PTO-1449 form) has not been provided. It has been placed in the application file, but the information referred to therein has not been considered.

***Response to Arguments***

2. Applicant's arguments filed November 29<sup>th</sup> 2007 have been fully considered but they are not persuasive.

Applicant's argues that, "Ginter describes that information described in information (logical object structure 800) is sent to the end user and not from the player device are found". Examiner respectfully disagrees. Ginter discloses that content objects may include administrative object (see [1019]), wherein the administrative objects can be used to transmit information for usage reporting, etc (see [1021]). In particular, it is disclosed that administrative objects (870) containing audit information in the data area of an event record can be sent **from end users to distributors** and/or clearinghouses and/or client administrators (see [1022]). The administrative objects contain public header 870 (see [1021]), wherein Ginter additionally discloses that, the public header identifies the object and may also identify one or more owner rights and/or **one or more distributors** of the object

(see [0989]). Therefore applicant's arguments stating that, "Ginter discloses 'metering' each time a consumer watches the video and reporting usage from time to time, but the metering does not describe or suggest receiving a from player device information identifying at least one distribution agent" and stating that, "Identifying only a title does not necessarily identify at least one distribution agent associated with the video item" are also found unpersuasive.

Examiner additionally notes that applicant did not traverse examiner's assertion of Official notice on claims 58 and 78. As applicant failed to traverse the examiner's assertion of Official notice, the well known fact in the art (i.e. that it is well known to transmit information for updating program guides) is taken to be admitted prior art.

For the reasons stated above, the rejection is maintained.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 41-42, 44-49, 51-52, 60-68, 70-76, and 100-106, are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (US Pre Grant Pub. 20040054630).

With regards to claim 41, Ginter discloses a video distribution method performed by a video distribution method, comprising:

Receiving video content from a content provider (see [0147]);

Providing player devices at remote viewing locations (electronic appliances under control of VDE, see [0081], [0450]), said players devices configured for reading, decoding (see [0450]), decompressing (see [0478]) and watermarking (see [0146], fingerprinting maybe performed in the user's local VDE installation subsystem), the player device configured for communicating with the video distribution system to permit the player devices to notify the system when a particular video item is viewed using any one of the player devices (see [0376]). Ginter additionally discloses that metering and usage information can be reported to server in real time or periodically using secure communications between the subsystems (see [0146]). Accordingly, the server (and other VDE subsystems) can establish communication connections with the player device;

Effecting the distribution of video disks to the remote viewing locations, the video disks including a plurality of video items recorded in an encoded and compressed format designed to be viewed using only the player devices (see [0126])

and [0147]), information is encrypted such that only the authorized party can decrypt it and hence decode it for viewing); and

After a video item is viewed by a consumer using one of the plurality of player devices at a remote viewing location (see [0450]), receiving from the particular one of the player devices, information (administrative object containing header 802 and audit information) identifying the video item viewed and at least one distribution agent associated with the video item viewed (see [0989], [1022]).

With regards to claim 60, Ginter discloses a system for distributing recorded digital data comprising:

At least one playback device for playing the at least one copy of digital data recording, wherein the at least one copy includes data identifying a distribution agent associated with the at least one copy (see [0416], [0989], [1022]); wherein the at least one playback device comprises an identification mechanism to identify contents of and the distribution agent associated with the at least one copy of the recording (see [0450], [1022]), wherein the at least one playback device is configured for reading, decoding (see [0450]), decompressing (see [478]), and watermarking (see [146]), and for communicating with a video distribution system to permit the playback device to notify the system when a particular recording is viewed (see [0376], [0146]), and wherein at the least one copy includes a plurality of video items recorded in an encoded and compressed format designed to be viewed using only the play back device (see [0126], i.e. authorized VDE receiver); and

A transmitting mechanism configured to transmit from the at least one playback device to the system, information identifying the contents of and the distribution agent associated with the at least one copy of the recording played by the at least one playback device (see [0989], [1022]). The VDE system associates rules and controls with content and prevents the content from being accessed unless the set of rules and controls is available (see [0399]). The ROS further is responsible for correlating the control information to prevent unauthorized use of the elements (see [0586]). Therefore Ginter teaches the step of digital recording having a multitude of a specified security code (control information), the playback device comprising a specified circuit (ROS) to prevent the at least one playback device from outputting data frames not having a specified security code.

With regards to claim 70, Ginter discloses a system for playing and for monitoring the playing of, digital recordings having given content authorized by a content provider, each of the recordings including data identifying an associated distribution agent (see [0416], [0989], [1022]), wherein the digital recording are distributed to consumers on video disks (optical discs, see [0013], [0189]) which includes a plurality of video items (see [0062], [2045]) recorded in an encoded and compressed format designed to be viewed by the consumer using only a playback device configured with proprietary circuitry (i.e. playback only at electronic appliances with VDE capabilities, see [0126], [0148])

At least one playback device for playing the at least one copy of the recording, wherein the at least one playback device comprises an identification

mechanism to identify contents of and the distribution agent associated with the at least one copy of the recording (see [0450], [1022]), wherein the at least one playback device is configured for reading, decoding (see [0450]), decompressing (see [478]), and watermarking (see [146]), and for communicating with a video distribution system to permit the playback device to notify the system when a particular recording is viewed (see [0376], [0146]).

A system controller configured to receive from the at least one playback device, information identifying the contents of and the distribution agent associated with the at least one copy of the recording played by the at least one playback device (see [0989], [1022]). The VDE system associates rules and controls with content and prevents the content from being accessed unless the set of rules and controls is available (see [0399]). The ROS further is responsible for correlating the control information to prevent unauthorized use of the elements (see [0586]). Therefore Ginter teaches the step of digital recording having a multitude of a specified security code (control information), the playback device comprising a specified circuit (ROS) to prevent the at least one playback device from outputting data frames not having a specified security code.

With regards to claim 100, Ginter discloses a system for playing and for monitoring the playing of, digital recordings having given content authorized by a content provider, each of the recordings including data identifying an associated distribution agent (see [0416], [0989], [1022]), wherein the digital recording are distributed to consumers on video disks (optical discs, see [0013], [0189]) which



includes a plurality of video items (see [0062], [2045]) recorded in an encoded and compressed format designed to be viewed by the consumer using only a playback device configured with proprietary circuitry (i.e. playback only at electronic appliances with VDE capabilities, see [0126], [0148])

At least one playback device for playing the at least one copy of the recording, wherein the at least one playback device comprises an identification mechanism to identify contents of and the distribution agent associated with the at least one copy of the recording (see [0450], [1022]), wherein the at least one playback device is configured for reading, decoding (see [0450]), decompressing (see [478]), and watermarking (see [146]), and for communicating with a video distribution system to permit the playback device to notify the system operator when a particular recording is viewed (see [0376]).

A transmitting mechanism configured to transmit from the at least one playback device to the system, information identifying the contents of and the distribution agent associated with the at least one copy of the recording played by the at least one playback device (see [0989], [1022]). The VDE system associates rules and controls with content and prevents the content from being accessed unless the set of rules and controls is available (see [0399]). The ROS further is responsible for correlating the control information to prevent unauthorized use of the elements (see [0586]). Therefore Ginter teaches the step of digital recording having a multitude of a specified security code (control information), the playback device comprising a

specified circuit (ROS) to prevent the at least one playback device from outputting data frames not having a specified security code.

In regards to claim 42 the distribution agent (publishing house) makes copies of the digital recorded data delivered to the distribution agent as per the limits set forth by the content creator, wherein data maybe delivered on optical discs. See [0013], [0189], [0380], and [0388].

In regards to claims 44, 62, and, 101, Ginter discloses receiving (metering) information identifying the viewed item and distribution agent associated with the item at the system operator location at defined times. See [0146].

In regards to claim 45, Ginter discloses the step of receiving information identifying the viewed item and distribution agent associated with the item at the system operator location indicating each time the recorded data is played. See Ginter [0376].

In regards to claims 46, Ginter discloses the step of charging the consumer based on the information received at the system operator location. See [0388]

In regards to claims 47, 74, and 103, Ginter discloses the step of charging the consumer a fee for each time the consumer plays the video data. See [0376]

In regards to claims 48, Ginter discloses a flexible metering scheme where a user can be charged each time a content is played or a user can be charged a single fee for accessing a content is played or a user can be charged a single fee for accessing a content unlimited times during a certain time duration. The user is charged a

variable fee for accesses during that subscribed time duration and a pay per play fee for accessing outside that subscription period. See [1083].

In regards to claims 49, Ginter discloses:

The distribution agent is a retail store. See [0010], and [0257]

The consumer obtains identified copies of the video data at retail stores [0257] and subsequently returns the identified copies to the retail stores (i.e. user rents content object). See [1004], [2071]. Accordingly the method further comprises the step of providing an identified copy of the video item to the consumer at the retail store and subsequently receiving the identified copies to the retail store.

In regards to claims 51, and 65, Ginter discloses the step of compensating the distribution agent for each time the video data distributed by the agent is paid. See [0256], [0376], [0388], and [1022]

In regards to claim 52, Ginter discloses the step of charging the distribution agent for recordings delivered to the distribution agent. See [0256], [0378]

In regards to claims 61, 71 and 73, Ginter discloses a receiving mechanism located at the system operator of the video distribution system configured to receive the information from the playback device and for using the information to determine compensation for the content provider and the distribution agents. See [0376], [0388], [1022].

In regards to claims 63, 72, and 102, the receiving act comprises receiving information at the system operator location (clearinghouse) from playback devices

(end users), the information identifying a copy of digital data recording and the distribution agents. See [0146], [0989] and [1022].

In regards to claims 64, Ginter discloses that the distribution network includes a plurality of retail stores. See [0010] and [0257]. Accordingly Ginter teaches a system wherein at least one copy is distributed in part through a retail store.

In regards to claims 66, 75 and 104, the playback device includes a specified circuit (VDE electronic appliances with rights operating system) that enables the playback device to play distributed copies of the recording. See [0458], [0459].

In regards to claims 68 and 106, the recorded digital data is a movie. See [0062].

In regards to claims, 67, 76 and 105, the digital data is recorded in a tangible medium and the tangible medium is an optical disc. See [0147].

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Knight (US Pat. 6,243,350).

In regards to claim 50, Ginter does not disclose the step of distributing the recorded data to the consumer at no charge.

Knight teaches the step of distributing a plurality of movies to a user on a cartridge for free, wherein the user may obtain access the movies on the disk after making some type of payment. See column 58, lines 40-59.

It would have been obvious to one of ordinary skill in the art to modify the system by distributing a disk comprising a plurality of movies to the user at no charge, and receive payments only when a movie is played. The motivation is to let the user obtain a library of movies at no charge, while charging the user only when content is used.

7. Claims 57-58, 77-78, is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715).

In regards to claims 57, and 77, Ginter does not disclose the step of providing the consumer with guides for identifying the multitude of copies of recorded data possessed by the consumer.

Yuen discloses the step of providing a guide (TIG) for identifying the plurality of recordings that are recorded in a storage medium. See abstract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by providing guide to identify the multitude copies of recorded data on a medium possessed by the consumer. The motivation is to provide an on screen navigation directory for guiding the user with program selection.

In regards to claims 58 and 78, the system does not comprise the step of transmitting data to update the information in guides.

Examiner takes official notice that it is well known to transmit information for updating guides.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by transmitting information to update the guides, in order to provide the user with the latest up to date information regarding the programs.

8. Claim 59, is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715), and Ward et al. (US Pre Grant Pub. 2005/0010949).

In regards to claim 59, the system does not disclose the step of updating guides with commercials based on the consumer's viewing of the played copies of digital data.

Ward et al. discloses the step of updating guides with commercials based on consumer's viewing habits, including played programs. See abstract, [0090], [0091] and [0306].

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system in view of Ward's teachings by updating commercials in the program guide based on consumer's viewing of played copies of digital data. The motivation is to provide the consumers with advertisements that fit their viewing profile, thereby providing them advertisements they are likely to have interested in.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UR

  
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